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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/726,961 | 12/03/2003 | Eric C. Erike | TRW(VSSIM)5875-1 | 4365 |

7590 08/29/2005

Tarolli, Sundheim, Covell & Tummino L.L.P.
1111 Leader Building
526 Superior Avenue
Cleveland, OH 44114-1400

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| EXAMINER |
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YEE, DEBORAH

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| ART UNIT | PAPER NUMBER |
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1742

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,961

Applicant(s)

ERIKE, ERIC C.

Examiner

Deborah Yee

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-03-03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 410140283.
3. JP'283 in claim 6 of the machine-english translation discloses a steel tube having a composition with constituents whose wt% ranges overlap those recited by the claims 1 to 7; such overlap establishes a prima facie case of obviousness because it would be obvious to one of ordinary skill in the art to select the claimed alloy wt% ranges from the broader disclosure of the prior art since the prior art teaches the same utility (apparatus for air bag application) and similar properties of high strength and low-temperature toughness, see MPEP 2144.05.
4. More specifically, prior art alloy 13 in the table of page 6 meets the claimed composition except for the presence of Mo. The Mo, however, would be an obvious incorporation since JP'283 teaches a broad range of 0.05 o 1.0%.
5. Furthermore similar to applicant's method claims 5 to 7, paragraphs 31 to 36 in the machine-english translation of JP'283 discloses processing seamless steel tube by subjecting a steel billet to a joint-less manufacturing –tube method such as punching by Mannesmann-mandrell mill method and hot rolling

(equivalent to piercing) followed by cold drawing, and hardening at 900C (within the recited temperature range of at least about 900C recited by claim 6 and about 900C recited by claim 7), quenching and tempering at 580C (within the recited temperature of at least about 500C recited by claim 6). Although induction heating recited by claim 7 is not taught by prior art, such would not be a patentable difference since such heating technique is well known and conventional in the metallurgical art; and hence would be a matter of choice well within the skill of the artisan to use.

6. Even though prior art does not teach a steel tube yielding plastically more than about 5% before fracturing at temperatures down to about -40C when stress sufficient to cause said steel tube to so yield is applied to said steel tube as recited by claims 1, 4, and 5, such property would be expected since composition and process limitations are closely met, and in absence of proof to the contrary.

7. Even though prior art does not teach the tensile and yield strength and elongation values recited by claims 3 and 4, such would be expected since composition and process limitations are closely met, and in absence of proof to the contrary.

8. Claims 1 to 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 406184635.

9. Claim 2 of the JP'635 machine-english translation discloses a seamless steel tube having a composition with constituents whose wt% ranges overlap

those recited by the claims 1 to 4; such overlap establishes a prima facie case of obviousness because it would be obvious to one of ordinary skill in the art to select the claimed alloy wt% ranges from the broader disclosure of the prior art since the prior art teaches similar properties of high yield strength and low-temperature toughness, see MPEP 2144.05.

10. See page 6 of English translation wherein specific steel alloy examples have a yield strength and high toughness at -40c which appear to meet the values recited by claims 3 and 4.

11. Even though prior art does not teach a steel tube yielding plastically more than about 5% before fracturing at temperatures down to about -40C when stress sufficient to cause said steel tube to so yield is applied to said steel tube as recited by claims 1 and 4, such property would be expected since composition yield strength and low-temperature toughness limitations are closely met, and in absence of proof to the contrary.

12. Even though prior art does not teach a tube produced in the same manner as claimed by present invention, such would not be a patentable distinction.

Note that in a product-by-process claim, the patentability is determined by the product per se and not the process. The burden falls to the applicant to show that any process steps associated with the claimed product result in a materially different product from those of the prior art, because there is nothing in the record before the examiner to reasonably conclude that applicant's product differs in kind from those obtained by the JP'635.

Double Patenting

13. Claims 1,2,3 and 5 of this application conflict with claims 19,21,22, and 29, respectively of Application No. 10/982,517. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1 to 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 18, 23 to 28, 31 and 32 of copending Application No. 10/982,517. Although


the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose apparatuses comprising low-carbon steel members made from compositions having constituents whose wt% are the same or overlapping . Moreover, property and process limitations are essentially the same. Also pending claims recite a tube which is a steel member and hence would meet the steel member limitation recited by claims 1 to 18 of application '517.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah Yee
Primary Examiner
Art Unit 1742

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